

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant : Christopher J. Dyl Art Unit : 3714  
Serial No. : 10/633,062 Examiner : Frank M. Leiva  
Filed : August 1, 2003 Conf. No. : 3611  
Title : Securing goal-activated game content

**MAIL STOP APPEAL BRIEF-PATENTS**

Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

## BRIEF ON APPEAL

### (1) Real Party in Interest

The real party in interest is Turbine, Inc. as indicated by an assignment recorded on reel 017577 and frame 0321, which is a subsidiary of Warner Brothers Entertainment, Inc..

## (2) Related Appeals and Interferences

There are no related appeals or interferences.

### (3) Status of Claims

Claims 1-23 stand rejected and are on appeal.

#### **(4) Status of Amendments**

All amendments have been entered. No amendments were filed after a final rejection.

**(5) Summary of Claimed Subject Matter**

**Claim 1.**

“A method for limiting dissemination of multi-media content in an online game” is shown in FIG. 4 and FIG. 5. Multimedia content is described on page 7, lines 14-16. The limitation of “at a server, hosting, for transmission, multi-media content designated as goal-activated content for an online game” is described in FIG. 1, which shows servers

104...108 and FIG. 3, as well as on page 8, between lines 10-14. The limitation of “receiving information indicating that a plurality of players is playing the online game on each of a corresponding plurality of clients” is described in FIG. 4, specifically at step 404. FIG. 1 shows clients 112...118 and servers 104...108. The limitation of “receiving information indicating that a first player from the plurality of players has completed a game challenge associated with the goal-activated content” is shown in FIG. 5, specifically at step 506, and described on page 9, lines 23-25. The limitation of “in response to receiving the information indicating that a first player from the plurality of players has completed a game challenge associated with the goal-activated content, transmitting the goal-activated content to a first client associated with the first player” is described on page 10, lines 3-10 and shown in FIG. 5 at step 516. The limitation of “instructing the first client to delete the goal-activated content stored on the first client” is described on page 8, lines 15-28 and on page 9, lines 7-10, as well as illustrated in FIG. 4 at steps 412 and 414.

#### **Claim 6**

“A method for limiting dissemination of multi-media content transmitted by a server in an online game” is shown in FIG. 4 and FIG. 5. Multimedia content is described on page 7, lines 14-16. The limitation of “transmitting, to the server, information indicating that a player has completed a challenge from the on-line game” is described on FIG. 5, specifically at step 506, and described on page 9, lines 23-25. The limitation of “requesting multi-media content designated as goal-activated content from the server” is illustrated in FIG. 5 at step 514 and described on lines 5-6 of page 10. The limitation of “receiving the goal-activated content from the server” is described in connection with FIG. 5, step 516 and page 10, lines 10-17. The limitation of “receiving an instruction from the server to delete the goal-activated content” is illustrated in FIG. 4 at step 412 and described at page 8, lines 15-28 and page 9, lines 7-10. The limitation of “deleting the goal-activated content” is described at page 8, lines 15-28 and on page 9, lines 7-10, as well as illustrated in FIG. 4 at step 414.

**Claim 13**

“A method for limiting dissemination of multi-media content transmitted by a server to a client in an online game” is shown in FIG. 4 and FIG. 5. Multimedia content is described on page 7, lines 14-16. The limitation of “at the server, designating selected multi-media content as goal-activated content” is described in connection with FIG. 1, which shows servers 104...108, and FIG. 3, and discussed on page 8 at lines 10-14. The limitation of “transmitting the goal-activated content to the client over a network” is described on page 10, lines 3-10 and shown in FIG. 5 at step 516. The limitation of “transmitting to the client, over the network, instructions to delete the goal-activated content” is described on page 8, lines 15-28 and on page 9, lines 7-10, as well as illustrated in FIG. 4 at steps 412 and 414.

**Claim 20**

“A computer-based multi-media content dissemination-limiting apparatus” is shown in FIG. 4 and FIG. 5. Multimedia content is described on page 7, lines 14-16. The limitation of “a non-volatile memory element storing data representative of multi-media content designated as goal-activated content” is inherent in connection with storing data on a server, as shown in FIG. 3 and described on page 8, lines 10-14. The limitation of “a transceiver for receiving a connection request from a remote client on a network” is inherent in the description of network communication on page 6, lines 2-15. The limitation of “a processor configured for” carrying out the listed steps is inherent since the steps are described as being carried out by a server 104...108, as shown in FIG. 1. That each server is a computer system is described between page 5, line 24 and page 6, line 2. The limitation of “determining that the goal-activated content is to be transmitted to the client” FIG. 5, specifically at step 506, and described on page 9, lines 23-25. The limitation of “causing the transceiver to transmit the goal-activated content to the client” is described on page 10, lines 3-10 and shown in FIG. 5 a step 516. The limitation of “causing the transceiver to transmit a deletion instruction for deleting the goal-activated content from the client” page 8, lines 15-28 and on page 9, lines 7-10, as well as illustrated in FIG. 4 at steps 412 and 414.

**Claim 21**

“A method for controlling access to multi-media content by clients in a multiplayer game” is shown in FIG. 4 and FIG. 5. Multimedia content is described on page 7, lines 14-16. The limitation of “maintaining a state for each player in a multiplayer game” is described at page 5, lines 26-29. The limitation of “storing multi-media content for distribution to clients associated with the players in the game, including storing content in association with each of a plurality of states that can be reached by at least some of the players” is shown in connection with FIG. 3, and with the clients and servers shown in FIG. 1, and described on page 8, lines 10-14. The limitation of “determining that a first player associated with a first client has reached a first state” FIG. 5, specifically at step 506, and described on page 9, lines 23-25.” The limitation of “permitting access to said multi-media content by the first player” is described on page 10, lines 3-10 and shown in FIG. 5 a step 516.

**(6) Grounds of Rejection to be Reviewed on Appeal**

1. Rejection of claims 1-19 and 21-23 as being rendered obvious under 35 USC 103(a) by *Walker* in view of *Nakano*.
2. Rejection of claim 20 as being rendered obvious under 35 USC 103(a) by *Nakano* in view of *Walker*.

**(7) Argument**

**Rejection of claims 1-19 and 21-23 as being rendered obvious under 35 USC 103(a) by *Walker* in view of *Nakano*.**

**SECTION 103 REJECTION OF CLAIM 6**

Claim 6 relates generally to on-line games. In an on-line game, the player plays on a client machine, which communicates with a game server.

To make an on-line game more interesting, the game-designers provide certain game challenges. A player who successfully completes one of these challenges receives certain content as a reward. This content is “goal-activated content.” Typically, a game

server sends the goal-activated content to the client, which then stores it on the player's behalf.

This goal-activated content is not intended to last forever. Once it expires, the player no longer uses it. One way to stop the player from using it is to leave it on the client machine, but to lock it in some way. However, a determined hacker can overcome such locks.

To avoid this difficulty, Applicant implemented a method that includes deleting goal-activated content from the client. The advantage of this method is that there are no locks for the determined hacker to overcome.

*Walker* discloses a system for attracting and retaining shoppers at a retail store. *Walker* understood that shoppers enjoy winning valuable prizes, and dislike the risk of losing money. *Walker* combined these ideas to invent a way to entice shoppers by providing the shoppers with an opportunity to play a lottery.

In *Walker*'s system, a shopper pays the shopkeeper a fee to enter a store lottery. He also tells the shopkeeper what merchandise he would like in the event that he wins the lottery.

The shop's computer then executes the lottery. Upon completion of the lottery, the shop's computer sends a message to a customer device concerning the lottery's outcome.

According to *Walker*, the customer device takes many forms. *Walker* describes it as being a personal digital assistant, a kiosk, a pager, a cell phone, a product code scanner, a shopping cart with a communication terminal, a video game, an ATM, a slot machine, a watch, a vending machine, an in-car communication system, a retailer terminal, or any device adapted to communicate with the shop's computer.<sup>1</sup>

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<sup>1</sup> *Walker*, col. 5, lines 8-40.

If the shopper wins the lottery, he obtains the merchandise. If the shopper loses the lottery, he receives either a store credit towards or a discount on that merchandise.

*Walker* plainly has nothing to do with limiting dissemination of multi-media content in an on-line game. *Walker*'s system is simply intended to attract shoppers to a store, and to retain them once there.

In an effort to read claim 6 on *Walker*, the Examiner begins by saying the store lottery is an "on-line game." The Examiner then points out that if the shopper were to designate, as the merchandise he wishes to win, a DVD, then that DVD would be "multi-media content designated as goal-activated content." Claim 6's "challenge from the on-line game" would then be the act of entering the lottery.

The Examiner recognizes that *Walker* never actually discloses the two limitations of "receiving an instruction from the server to delete goal-activated content" and "deleting the goal-activated content." To supply both of these missing limitations, the Examiner introduces *Nakano*.

*Nakano* discloses a video recorder that erases video content after the lapse of some interval. The purpose of erasure is related to digital rights management.

The Examiner says that after having won certain content in a lottery, and after having transferred this content to a home computer, it would have been obvious to then delete this goal-activated content "to use all available web store teachings for the stores used in *Walker*'s invention."

The proposed motivation to modify *Walker* is flawed because essentially it says that anything remotely connected with a field of use would have been a basis for modifying a method associated with the field of use. The mere fact that there are teachings about web stores that are not set forth in *Walker* does not automatically mean that those one of ordinary skill in the art would have thought to modify *Walker* in

accordance with those teachings. If the law were as the Examiner proposes, then essentially nothing would be patentable.

As best as Applicant can reconstruct, the Examiner maps claim 6 to the combination of references in the manner set forth in the following table. It should be noted that Applicant is not admitting the references disclose or suggests the steps in the right-hand column. These steps are only an attempt to articulate the Examiner's thoughts.

|  |   |
|--|---|
| A method for limiting dissemination of multi-media content transmitted by a server in an online game, the method comprising: | In a store equipped with <i>Walker</i> 's system, a shopper chooses multimedia content as a prize in a store lottery. This content can only be watched for a finite viewing time. |
| [a] transmitting, to the server, information indicating that a player has completed a challenge from the on-line game;       | The retail controller 100 sends a message to the shopper's device 200 indicating that the shopper has won the lottery.  |
| [b] requesting multi-media content designated as goal-activated content from the server;                                     | The shopper's device 200 asks controller 100 to send the prize (i.e. the multimedia content) to a <i>Nakano</i> video recorder.   |
| [c] receiving the goal-activated content from the server;  | The controller 100 then transmits the content to the <i>Nakano</i> video recorder.  |
| [d] receiving an instruction from the server to delete the goal-activated content; and                                       | Upon lapse of the finite viewing time, <i>Nakano</i> 's video recorder receives an instruction from the retail controller 100 to delete the multi-media content.                  |
| [e] deleting the goal-activated content.   | The <i>Nakano</i> video recorder deletes the multi-media content won by shopper.  |

The Examiner's rejection fails in large part because the flow of information between client and server is inconsistent with that in the claim.

**Combination fails to teach or suggest step [a]**  
Step [a] requires

“transmitting, to the server, information indicating that a player has completed a challenge from the on-line game;”

The combination of *Walker* and *Nakano* fails to teach or suggest step [a] because step [a] requires that the information indicating completion of a challenge be transmitted “to the server.” Because the Examiner has identified “client” with personal device 200 and “server” with retail controller 100, the resulting flow of information is inconsistent with that recited in the claim limitation. In *Walker*, instead of being transmitted “to the server” as required, the information that would correspond to that recited in step [a] is transmitted “to the client” from the retail controller 100.

In *Walker*, a shopper learns of his winnings when retail controller 100 (i.e. claim 6’s “server”) sends customer device 200 (i.e. the claim 6’s “client”) a message. In fact, it wouldn’t be possible for information to flow any other way because device 200 has no other way to find out who won the lottery. Thus, the flow of information is the exact opposite of that recited in step [a]. In *Walker*, information about completing a challenge comes from the server, not from the client.

#### **Combination fails to teach or suggest step [d]**

Step [d] recites

“receiving an instruction from the server to delete the goal-activated content;”

The combination fails to teach or suggest step [d] because *Nakano*’s video recorder does not receive external instructions to delete content.<sup>2</sup> In *Nakano*, the decision to delete content occurs without instruction from any server. *Nakano* has an internal clock that can be used to determine when the viewing period for particular content will expire.

One of ordinary skill in the art would have realized that if the *Nakano* system operated as the claim recites, one could improperly extend the viewing period for content. To do so, one would disconnect the video recorder from any network just prior

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<sup>2</sup> *Nakano*’s video recorder receives content over a network, but not deletion instructions.

to the lapse of the viewing period. This would ensure that the delete instruction never arrives at the video recorder.

The situation is different in an on-line game. One can watch a recorded movie without having to be connected to a network. In fact, this is what most people did in the days when video rental stores reigned supreme. In contrast, an on-line game generally requires a connection to a game server. Thus, one of ordinary skill in the art would have realized that *Nakano* 's method for controlling dissemination of content would not work effectively.

Accordingly, the combination fails to teach or suggest “receiving an instruction from the server to delete” any content.

**Combination fails to teach or suggest steps [b] and [c]**

Steps [b] and [c] require

“requesting multi-media content designated as goal-activated content from the server;” and

“receiving the goal-activated content from the server;”

The combination also fails to teach or suggest steps [b] and [c] because steps [b] and [c] require that content be requested “from the server” (i.e. “requesting...content from the server”) and received “from the server” (i.e. “receiving...content from the server”).

According to *Walker*, the retail controller executes the lottery and notifies shoppers of their winnings. The actual prizes are claimed at a cash register or shipped to the shopper. There is no disclosure, express or implied, of the fact that the retail controller, in addition to executing the lottery, also has the function of distributing multi-media content to prize winners.

**Placing a bet is not accepting or issuing a challenge**

Claim 6 requires

transmitting, to the server, information indicating that a player has completed a challenge from the on-line game

One of ordinary skill in the art would not have regarded winning a lottery as having “completed a challenge.”

The Examiner’s position is that “placing a bet” is no different from “accepting a challenge.” The Examiner sees no difference between “winning a bet” and “completing the challenge.” In the Examiner’s view, a shopper accepts the store’s “challenge” by paying an entry fee for the lottery. The shopper then completes this “challenge” upon being notified of having won the lottery. Thus, under the Examiner’s interpretation, the store is the challenger, and the shopper accepts the store’s challenge by paying an entry fee. According to the Examiner, the shopper completes the challenge by winning the prize.

However, the Examiner could have just as easily have said that the shopper issues the challenge by offering an entry fee, and that the store accepts the challenge by accepting the fee. Under this interpretation, the store that completes the challenge by issuing only a store credit rather than the requested prize.

Under the Examiner’s interpretation, there is no basis to prefer one over the other. The Examiner’s interpretation provides no way to determine if the store is the challenger, or if the shopper is the challenger. The fact that one cannot identify a challenger provides evidence for the proposition that, contrary to what the Examiner says, the transaction between store and shopper does not involve any sort of “challenge” as that word is used either by one of ordinary skill in the art or by any normal speaker of the English language.

In addition, the Examiner’s semantic reconstruction of the word “challenge” leads to results that are inconsistent with how one of ordinary skill in the art, or for that matter, any speaker of the English language, would understand the word.

For example, at its core, insurance is a betting game. In an insurance contract, insurer and insured both bet on whether a risk will materialize within a policy period. The “entry fee” from *Walker’s* lottery would become the policy premium.

Under the Examiner’s interpretation, it would logically follow that the act of buying, for example, life insurance amounts to accepting a challenge from the insurer. According to the Examiner’s interpretation, the insured party would successfully complete this “challenge” by dying during the policy period.

Such a twisted and ludicrous result does not arise from false logic, but from false premises. It is the inevitable result of a somewhat absurd construction of the ordinary English word “challenge.” Contrary to the Examiner’s interpretation, one of ordinary skill in the art would never have regarded “placing a bet” as being the same thing as “accepting a challenge.”

The Examiner’s absurd interpretation of “challenge” calls to mind the words of Justice Burger in *TVA v. Hill*, in which he characterized Justice Powell’s interpretation of the word “actions” as follows:

“Aside from this bare assertion, however, no explanation is given to support the proffered interpretation. This recalls Lewis Carroll’s classic advice on the construction of language:

“‘When I use a word,’ Humpty Dumpty said, in rather a scornful tone, ‘it means just what I choose it to mean -- neither more nor less.’” Through the Looking Glass, in The Complete Works of Lewis Carroll 196 (1939)<sup>3</sup>”

### **Summary**

The section 103 rejection of claim 6 is improper for at least four reasons.

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<sup>3</sup> *Tennessee Valley Authority v. Hill*, 437 US 153 (1978) footnote 18.

First, the combination fails to teach or suggest “transmitting, to the server, information indicating that a player has completed a challenge from the on-line game.” In *Walker*, such information would flow from the server, not to the server.

Second, the combination fails to teach or suggest “receiving an instruction from the server to delete the goal-activated content.” In *Nakano*, deletion takes place without any communication from any server.

Third, the rejection relies on an egregiously contrived construction of the word “challenge.” One of ordinary skill in the art would never regard winning a lottery as having “completed a challenge.”

Finally, the combination of references fails to teach or suggest receiving goal-activated content from the server because the retail controller only manages the lottery. It does not store multi-media content.

## **SECTION 103 REJECTION OF CLAIM 1**

Claim 1 recites the limitation:

receiving information indicating that a first player from the plurality of players has completed a game challenge associated with the goal-activated content,

Thus, according to claim 1, the first player must have “completed a game challenge.” For reasons already discussed in connection with claim 6, one who has won a lottery cannot reasonably be viewed having “completed a game challenge.”

Claim 1 also requires

“instructing the first client to delete the goal-activated content stored on the first client.”

In rejecting claim 1, the Examiner says that the claim 1's clients correspond to the customer devices 200.<sup>4</sup> This is consistent with the following claim limitation:

“receiving information indicating that a plurality of players is playing the online game on each of a corresponding plurality of clients,”

However, *Walker* says nothing about these customer devices 200 deleting content. To remedy this, the Examiner appears to switch gears at around paragraph 4 of the claim. At paragraph 4, claim 1's “clients” transition from being *Walker*'s customer devices into a *Nakano* video recorder.

This transition makes no sense at all. *Nakano*'s video recorder stores content. It does not play an on-line game as required by the rest of the claim. As a result of this changeover, the Examiner's rejection falls apart.

As discussed in connection with claim 6, *Nakano*'s video recorder deletes content without having to receive instructions to do so. Thus, nothing ever instructs *Nakano* to delete any content. Accordingly, the step of

“instructing the first client [*Nakano* video recorder] to delete the goal-activated content stored on the first client [*Nakano* video tape recorder].”

cannot be met because *Nakano* does not receive instructions for deleting content.

Claim 1 further includes the limitation of

“at a server, hosting, for transmission, multi-media content.”

The Examiner has identified *Walker*'s retail controller as being claim 1's “server.” But the only thing *Walker*'s retail controller actually hosts is the lottery. There is no disclosure in *Walker* of the retail controller 100 hosting multi-media content.

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<sup>4</sup> See *Final Action*, page 11, where the Examiner refers to several discussions of customer devices at *Walker*, col. 6, lines 35-52 and elsewhere.

Moreover, even if the retail controller did host such content, it would certainly not host content “designated as goal-activated content for an online game.”

The Examiner says that the act of designating content as goal-activated content occurs whenever a shopper says he wishes to win particular content. But this would occur at the retail device 200, not at the retail controller 100.

### **SECTION 103 REJECTION OF CLAIM 13**

Claim 13 includes the limitation of

“at the server, designating selected multi-media content as goal-activated content.”

The Examiner has identified the retail controller 100 as corresponding to the claim’s “server.” The Examiner has also identified the prize that the shopper hopes to win as being “goal-activated content.”

The only remaining question then is “Where does the act of choosing the prize (i.e. “designating...goal-activated content”) actually occur?

The answer is straightforward. It occurs at the customer device 200. Why? Because it is with customer device 200 that the customer interacts. But according to the Examiner, customer device 200 is not the “server”; it is the client.

Therefore, to the extent *Walker* can be said to disclose designating content as goal-activated content, it does so only at the client, not at the server as the claim requires. *Walker* fails to teach or suggest the limitation of “at the server, designating selected multi-media content as goal-activated content” because any such act of designation in *Walker* occurs at the client (customer device 200) and not at the server (retailed controller 100).

### **SECTION 103 REJECTION OF CLAIM 21**

The prior art fails to teach or suggest

“storing multi-media content for distribution to clients associated with the players in the game, including storing content in association with each of a plurality of states that can be reached by at least some of the players;”

According to the examiner, *Walker* suggests storing a movie “in association with” the state of winning the lottery.

However, the claim requires storing content in association with at least two states.

In *Walker*, there are only really three states a lottery player can be in: (1) winning the lottery; (2) losing the lottery; and (3) still playing the lottery. *Walker*’s FIG. 8 shows that for state (1), the system provides the product, and for state (2) the system credits a portion of a fee. *Walker* is silent concerning state (3).

The Examiner alleges that he has identified storing content “in association with” state (1), namely the state of winning. But he has not even tried to identify any content that is stored “in association with” either state (2) or state (3).

The Examiner’s rejection is ultimately the product of considerable speculation. He first says that based on *Walker*, which describes awarding store merchandise as a prize, one of ordinary skill in the art would have thought of awarding a movie on a DVD. Then the Examiner takes another step away from the prior art. He dispenses with the physical media altogether. According to the Examiner, it also would have been obvious to simply send the movie directly to the prize winner.

Now, in the context of claim 21, the Examiner takes yet another step away from the cited art. The Examiner proposes that one of ordinary skill in the art would have found it obvious to store content “in association with each of a plurality of states” i.e. not just in association with winning the lottery but also in association with losing the lottery.

Presumably, if the state is “winning,” the stored content would be whatever movie the shopper selected. But what is the stored content for the remaining two states? According to FIG. 8, for state (2), the system simply credits a fee. A credit of a fee is

certainly not stored content. As for state (3), nothing comes to mind as being a plausible candidate for stored content.

Accordingly, the combination of references does not render the claim obvious because nowhere does the combination teach or suggest storing content “in association with each of a plurality of states.” Neither reference teaches or suggests storing content in association with the state of losing the lottery and the state of neither winning nor losing the lottery.

#### **SECTION 103 REJECTION OF CLAIMS 3, 8, AND 16**

Claim 3 is patentably distinct over the art because in *Walker*, the purchase history is not received from a client. Instead it is maintained at the server.

Claim 3 recites the additional limitation of

“receiving a history profile from the first client”

Thus, according to the claim, the history profile must be received from the first client.

Although *Walker* does indeed disclose a customer purchase history, that purchase history is never received “from the first client.”

*Walker*’s system maintains a customer database.<sup>5</sup> The customer database lists the customer’s name, address, preferred mode of payment, and a “customer rating.” The “customer rating” depends on the customer’s purchase history.<sup>6</sup> The more spendthrift are rated “gold” and relatively parsimonious are rated “bronze.”

Thus, according to *Walker*, somewhere a purchase history is being maintained and used to assign customer ratings in a customer database.

On the other hand, it is one thing to say that a purchase history exists, but quite another to say that it is “received from the first client.”

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<sup>5</sup> *Walker* FIG. 5 and col. 10, lines 51-67, as cited by examiner.

<sup>6</sup> *Walker*, col. 11, lines 30-39, as cited by examiner.

In rejecting claim 1, the Examiner says that the “client” corresponds to the customer devices 200 that the customer uses when playing the lottery. Thus, to suggest the claim limitation, one of ordinary skill in the art would have to think of the idea of keeping a purchase history on one of these customer devices, and then somehow sending this purchase history to someplace else, which could then be said to have received “a history profile from the first client.”

The Examiner has not indicated why one of ordinary skill in the art would think of storing a purchase history on one of these devices, and then sending that purchase history someplace else, for example to the store for use in updating the customer database.

The more reasonable inference is that in *Walker*, the system collects purchase data at the point of sale, and sends it to some central computer that maintains a purchase history.

Consequently, there is no plausible reason for believing that the prior art teaches or suggests receiving a history profile from a client.

Claims 8 and 16 include limitations similar to claim 3 and are patentable for at least the same reasons.

#### **SECTION 103 REJECTION OF CLAIMS 4, 9, AND 17**

Claim 4 recites the further limitation of

“instructing the first client to delete goal-activated content stored on the first client in accordance with the history profile.”

In rejecting claim 3, the Examiner said that “history profile” corresponded to a purchase history maintained by *Walker* for the purpose of rating customers on the basis of their purchases in the customer database shown in *Walker*’s FIG. 5.

In moving down to claim 4, the Examiner has now changed what it is that corresponds to the claimed "history profile."<sup>7</sup> Instead of being a purchase history, as it was in claim 3, the Examiner now says that the "history profile" is a record of pauses, plays, and stops that occur while someone is using the *Nakano* video recorder to watch a show.

According to the Examiner's theory, the *Nakano* video recorder keeps track of how long the viewer spends in pause mode, how long he spends in play mode, and how long he spends in stop mode. The Examiner then theorizes that the *Nakano* video recorder somehow uses all this information to decide whether or not it is time to delete certain content.

As an initial matter, it is not even clear that *Nakano*'s video recorder bothers to keep track of every single pause and how long it lasts. Applicant agrees that pausing, stopping, and playing are inherent functions of a video playback unit. But there is no disclosure in *Nakano* of actually keeping track of how long the viewer spends in each state.

In addition, even if *Nakano* did keep track of all this information, it is unclear why it would matter. After all, the *Nakano* device is deletes content after lapse of a certain time. This does not depend on how much time the viewer spends paused, stopped, or in play mode. In fact, the *Nakano* device would delete content even if the viewer has never actually watched it.

Accordingly, the Examiner's theory that somehow a history of pauses, stops, and plays is somehow relevant to deciding whether to delete content is inconsistent with the evidence.

In fact, *Nakano*'s video recorder deletes content based on how long the content has been on disk. This does not depend on how many times the user found it necessary to

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<sup>7</sup> *Final Action*, page 6.

pause while watching the content. For at least this reason, the section 103 rejection is improper and should be reversed.

### **SECTION 103 REJECTION OF CLAIM 5**

Claim 5 recites the additional limitation of

“encrypting the goal-activated content prior to transmission to the first client.”

The Examiner states that “inherent in MPEG files is [sic] coded/encrypted materials for the purpose of limiting play to specific media providers.”

Since the Examiner has not provided any evidence of this fact, Applicant assumes the Examiner is attempting to take Official Notice.

MPEG is merely a particular standard for encoding data. It is unclear from a technical point of view what exactly it means for encrypted material to be “inherent” in MPEG files. An MPEG file, like any other file, can be encrypted or not. But this does not mean that encrypted material is somehow “inherent” in an MPEG file. For example, a simple ASCII text file can also be encrypted or not, but nobody would seriously argue that encrypted material is somehow “inherent” in an ASCII file.

The Examiner then states that it would have been obvious “to use the time encryption method in *Nakano* to establish the viewable period.”

It is unclear what “time encryption method” *Nakano* discloses, or for that matter, what “time encryption” really means. Paragraphs 58 and 105, which the Examiner cites, do not discuss anything that sounds like “time encryption.”

In addition, it is unclear why any encryption would be needed to establish a “viewable period” of any content.

### **SECTION 103 REJECTION OF CLAIMS 10 AND 18**

Claim 10 recites the additional limitation of

“receiving an instruction to delete all goal-activated content.”

The Examiner concedes that *Nakano* fails to teach claim 10's limitation of "receiving an instruction to delete all goal-activated content." However, the Examiner suggests that one of ordinary skill in the art would have found this obvious "to maximize improvement of *Walker/Nakano* invention by making it more versatile and easy to use."<sup>8</sup>

The Examiner's statement is a "mere conclusory statement" of the type forbidden by *KSR v. Teleflex*. It offers no reason for why one would have found it obvious to modify *Nakano* by allowing receipt of an instruction to delete all goal-activated content.

Contrary to the Examiner's position, one of ordinary skill in the art would have recognized that deleting all content would sometimes result in deleting video programming that has only just been placed on disk. This would defeat the purpose of *Nakano*, which is to delete only expired video programming.

In the final action, the Examiner states:

"The examiner's position on a broad claim such as claims 10 and 18 mentions no reason for which [sic] the server would delete all content, and it is the examiner's position that the server following the previous claims to delete content only after reviewing the clients [sic] history profile would have realized all the content used or past due and clear all content. It would be inherent in conclusion that if all the content has expire [sic] to delete all the content."

As best understood, the Examiner's position is that in the long run, all content on the *Nakano* video recorder will expire, and therefore in the long run, all of it will be deleted.

The Examiner's position is flawed for at least three reasons.

First, one of ordinary skill in the art would have realized that it is quite possible for the *Nakano* view recorder to store content that does not have an expiration date. The mere fact that the *Nakano* video recorder can recognize and delete expired content does not mean that all content will expire.

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<sup>8</sup> *Office Action*, page 4.

Second, the fact that all content will ultimately expire on *Nakano*'s disk does not mean that all content will be deleted at once by a single command to delete all content. One of ordinary skill in the art would have found it more reasonable, particularly in an application like *Nakano*'s, to delete content as it expires.

Third, a command to delete all content in *Nakano*'s video recorder would inevitably delete unexpired as well as expired content. Thus, one of ordinary skill in the art would regard such a command as not being a good idea.

**Rejection of claim 20 as being rendered obvious under 35 USC 103(a) by *Nakano* in view of *Walker*.**

#### **SECTION 103 REJECTION OF CLAIM 20**

Claim 20 recites

“a transceiver for receiving a connection request from a remote client on a network”

As best understood, the Examiner regards claim 20's transceiver as corresponding to the network interface in the *Nakano* video recorder.

The transceiver on a *Nakano* video recorder is clearly not something that receives connection requests from remote clients on a network. A transceiver with that capability would be expected to exist on a server, not on a video tape recorder. A video tape recorder that happens to have a network interface might be expected to have a network interface that receives content from a server. It would not be expected to have a network interface that can receive connection requests from a remote client because it would never be expected to carry out such a function.

Claim 20 also recites the limitation of

“causing the transceiver to transmit a deletion instruction for deleting the goal-activated content from the client.”

The Examiner says that the transceiver on the *Nakano* video recorder corresponds to the transceiver of claim 20. But there is no mention in *Nakano* of using the transceiver to

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transmit or receive instructions to delete content. *Nakano* only describes the transceiver as being used for receiving content.

It is true that *Nakano* can delete content. But it does so all by itself. It does not need to receive an instruction to do so from some other device. It uses its own internal clock (current-time capture block 14). It does not rely on any signal that comes in through its "broadcast/communication signal input."

Accordingly, the combination does not teach or suggest "causing the transceiver to transmit a deletion instruction for deleting the goal-activated content from the client" because the *Nakano* device does not wait for a delete instruction to arrive through a transceiver. It simply deletes content all by itself by using an internal clock.

### Conclusion

The appeal brief fee in the amount of \$540 is being paid concurrently herewith on the Electronic Filing System (EFS) by way of Deposit Account authorization. Please apply all charges or credits to Deposit Account No. 50-4189, referencing Attorney Docket No. 30064-015001.

Respectfully submitted,

Date: 10-4-2010

  
Faustino Lichauco  
Reg. No. 41,942

Customer No. 69713  
Occhiuti Rohlicek & Tsao LLP  
10 Fawcett Street  
Cambridge, MA 02138  
Telephone: 617-500-2533  
Facsimile: (617) 500-2499

**(8) Claims Appendix**

1. A method for limiting dissemination of multi-media content in an online game, the method comprising:

at a server, hosting, for transmission, multi-media content designated as goal-activated content for an online game;

receiving information indicating that a plurality of players is playing the online game on each of a corresponding plurality of clients,

receiving information indicating that a first player from the plurality of players has completed a game challenge associated with the goal-activated content,

in response to receiving the information indicating that a first player from the plurality of players has completed a game challenge associated with the goal-activated content,  
transmitting the goal-activated content to a first client associated with the first player; and

instructing the first client to delete the goal-activated content stored on the first client.

2. The method of claim 1, wherein transmitting the goal-activated content comprises transmitting the goal-activated content to the first client in response to a determination that the first player completed the game challenge.
3. The method of claim 1, further comprising receiving a history profile from the first client.
4. The method of claim 3, wherein instructing the first client to delete the goal-activated content comprises instructing the first client to delete goal-

activated content stored on the first client in accordance with the history profile.

5. The method of claim 1, further comprising encrypting the goal-activated content prior to transmission to the first client.
6. A method for limiting dissemination of multi-media content transmitted by a server in an online game, the method comprising:

transmitting, to the server, information indicating that a player has completed a challenge from the on-line game;

requesting multi-media content designated as goal-activated content from the server;

receiving the goal-activated content from the server;

receiving an instruction from the server to delete the goal-activated content; and

deleting the goal-activated content.

7. The method of claim 6, wherein receiving an instruction from the server to delete goal-activated content comprises receiving, upon initialization of an executable program, an instruction to delete the goal-activated content.
8. The method of claim 6, further comprising

maintaining a history profile having information about content received from the server and

sending the history profile to the server.

9. The method of claim 8, wherein receiving an instruction from the server to delete goal-activated content comprises receiving an instruction to delete the goal-activated content in accordance with the history profile.

10. The method of claim 6, wherein receiving an instruction from the server to delete goal-activated content comprises receiving an instruction to delete all goal-activated content.
11. The method of claim 6, further comprising determining that a player has fulfilled a goal.
12. The method of claim 11, wherein requesting goal-activated content from the server comprises requesting goal-activated content in response to the completion of the game challenge.
13. A method for limiting dissemination of multi-media content transmitted by a server to a client in an online game, the method comprising:
  - at the server, designating selected multi-media content as goal-activated content;
  - transmitting the goal-activated content to the client over a network; and
  - transmitting to the client, over the network, instructions to delete the goal-activated content.
14. The method of claim 13, further comprising
  - authenticating completion of the challenge by a player associated with the client.
15. The method of claim 14, wherein transmitting the goal-activated content comprises transmitting the goal-activated content to the client in response to the authentication.
16. The method of claim 13, further comprising

receiving a history profile maintained by the client, the history profile including information about goal-activated content received from the server.

17. The method of claim 16, wherein instructing the client to delete the goal-activated content comprises instructing the client to delete goal-activated content in accordance with the history profile.
18. The method of claim 13, wherein instructing the client to delete the goal-activated content comprises instructing the client to delete all goal-activated content stored on the client.
19. The method of claims 13, wherein instructing the client to delete the goal-activated content comprises instructing the client to delete all goal-activated content upon initialization of an executable program by the client.
20. A computer-based multi-media content dissemination-limiting apparatus comprising:

a non-volatile memory element storing data representative of multi-media content designated as goal-activated content;

a transceiver for receiving a connection request from a remote client on a network;

a processor configured for

determining that the goal-activated content is to be transmitted to the client;

causing the transceiver to transmit the goal-activated content to the client; and

causing the transceiver to transmit a deletion instruction for deleting the goal-activated content from the client.

21. A method for controlling access to multi-media content by clients in a multiplayer game, the method comprising:

maintaining a state for each player in a multiplayer game;

storing multi-media content for distribution to clients associated with the players in the game, including storing content in association with each of a plurality of states that can be reached by at least some of the players;

determining that a first player associated with a first client has reached a first state, and

permitting access to said multi-media content by the first player.

22. The method of claim 21, wherein the state for a player comprises the state of having completed a game challenge.

23. The method of claim 21, wherein determining whether the first player associated with the first client has reached the first state comprises determining whether the player has completed a game challenge.

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**(9) Evidence Appendix**

NONE

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**(10) Related Proceedings Appendix**

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